

REMARKS

This application has been reviewed in light of the Office Action dated August 22, 2006. Claims 1, 2, 34, and 35 are presented for examination. Claims 1 and 2 have been amended to define more clearly what Applicants regard as their invention. Claims 34 and 35 have been added to provide Applicants with a more complete scope of protection. Claim 1 is in independent form. Favorable reconsideration is requested.

Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,318,435 ("Heath-Coleman") or, alternatively, U.S. Patent No. 5,626,696 ("Boni").

Claim 1 is directed to a safety insert designed to be mounted in an assembly comprising a tire and a rim of a vehicle and radially on the outside of the rim. The insert has a radially outer bearing surface which defines a radial bearing for the crown of the tire when the tire is deflated and means for generating vibrating warning signals on a run-flat condition. The means is configured to generate the vibrating warning signals by generating vibrations oriented in a transverse direction, parallel to an axis of rotation of the tire and rim assembly.

Heath-Coleman relates to a run-flat safety support that is designed to fit around the rim of the vehicle. The support is formed of a number of elongate blocks that fit into a well in the rim. The blocks are spaced and retained by reinforced rubber belts. The belts have protruding portions (13b) that extend in a radial direction. As such, these structures result in vibrations in the radial direction, rather than in a transverse direction, as claimed.

It is therefore respectfully submitted that nothing has been found or pointed out in Heath-Coleman that would teach or suggest a means configured to generate the vibrating warning signals by generating vibrations oriented in a transverse direction, parallel to an axis of rotation of the tire and rim assembly, as recited in Claim 1.

Boni also relates to a run-flat safety support. The support may include small strips (48) that extend in the radial direction and therefore generate radial vibrations as the tire rotates. Nothing has been found or pointed out in Boni that would teach or suggest a means configured to generate the vibrating warning signals by generating vibrations oriented in a transverse direction, parallel to an axis of rotation of the tire and rim assembly, as recited in Claim 1.

It is contended in the Office Action that Heath-Coleman and Boni inherently disclose a structure that generates the claimed warning signals. The Examiner appears to be relying on the portion of the M.P.E.P. which states that “once a reference teaching [a] product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference.” M.P.E.P. 2112(IV).

To support this theory of inherency, the Examiner asserts that Heath-Coleman and Boni disclose “transverse variation in height of [an] outer surface”, which the Examiner equates with “variation of transverse position according to azimuth” (see Office Action at pages 2-3). However, a transverse variation in height of an outer surface does not necessarily result in a variation of transverse position according to azimuth. To the contrary, the position of Heath-Coleman’s belts (13) and protrusions (13b) are at a fixed

transverse position with respect to azimuth, i.e., the transverse position of the belts, as seen for example in the cross-section view of Fig. 1, does not vary as the tire rotates. Similarly, the position of Boni's strips (48) are fixed in the transverse direction with respect to azimuth, i.e., the position of the strips, as seen for example in the cross-section view of Fig. 8, does not vary as the tire rotates. Thus, neither Heath-Coleman nor Boni discloses a structure that varies in transverse position according to azimuth, as the Examiner asserts.¹

It is therefore respectfully submitted that the rationale put forth by the Examiner does not support a theory of inherency with respect to the cited references.

For at least these reasons, Claim 1 is believed to be patentable over the cited references.

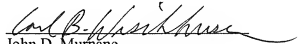
The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

¹ Applicants note that a structure that varies in transverse position according to azimuth is but one possible embodiment of the claimed invention, e.g., as shown in Fig. 2, and the claims are not limited to such a structure.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



John D. Murnane
Registration No. 29,836
(212) 218-2527

Carl B. Wischhusen
Registration No. 43,279
(212) 218-2582

Attorneys for Applicants

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_Main 593381_1